

Application No. 10/509,249  
Attorney Docket No. 12480-000067/US

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**REMARKS**

No claims having been added or canceled, the Applicants contend that claims 1-28 remain pending in this application.

**Restriction Requirement**

The Examiner has requested an election under 35 U.S.C. § 121 among various inventions identified in the originally filed claims of the application, the claim groups and inventions being identified as:

- |          |                                                                                                                                                                                                                                                                      |
|----------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Group I  | Claims 1-16 and 18-27, drawn to a drug that comprises hollow nanoparticles of particle-forming protein, the protein displaying an antibody against a specific cell or tissue and encapsulating a substance to be transferred to the cell for treating a disease; and |
| Group II | Claims 17 and 28, drawn to a disease treating methods comprising administering the nanoparticle.                                                                                                                                                                     |

**Applicants' Response to Restriction**

In response to this restriction requirement, the Applicants elect, with traverse, the invention of claims 1-16 and 18-27 (the Group I claims ) drawn to a drug that comprises hollow nanoparticles of particle-forming protein, the protein displaying an antibody against a specific cell or tissue and encapsulating a substance to be transferred to the cell for treating a disease.

**Argument in Support of Traversal**

The Applicants contend that the use of the drugs corresponding to the Group I claims in the methods of treatment recited in the Group II claims present a conventional product/product

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use whereby examination of both groups of claims would not constitute a "serious burden." MPEP § 803. The Applicants further note that an examination of the inventorship of the present application and the cited U.S. Published Patent Appl. No. 2003/0092069 ("Kuroda") demonstrates the Applicants' solid basis for evaluating the advancement of the art reflected in the present application and their contention that the teachings of Kuroda do not destroy the unity of the pending claims.

### **Species Election**

The Examiner has also requested election of a single species for each generic "drug" and "disease" to which the invention will be restricted if no generic claim is found allowable. Action at 2-3.

### **Applicants' Response to Species Requirement**

The Applicants elect, with traverse, a modified hepatitis B virus surface antigen protein as the particle-forming protein. The Applicants submit that antibody selection is a function of the target into which the encapsulated substance is to be transferred. The Applicants contend that each such antibody shares the special technical feature of binding to a corresponding surface, election of a single antibody is not warranted. Similarly, with respect to the encapsulated substance the Applicants submit that the selection is a function of the effect desired at the target and that each such substance shares the special technical feature of providing the desired function. Accordingly, the Applicants elect the Markush group consisting of DNA, RNA, proteins and peptides.

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The Applicants submit that claim 1 is generic and that claims 1-16 and 18-27 read on the elected species.

**Arguments in Support of Traversal**

The Applicants submit that the present Action does not:

(A) Identify the generic claims or indicate that no generic claims are present [or]

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are to be restricted. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted. Provide reasons why the species are independent or distinct.

MPEP § 809.02(a). Indeed, the Applicants note that the guidance provided in the Action states only that “[t]he claims are generic to a myriad of possible ‘drugs’, [sic] including the elements: protein, antibody against a specific tissue or cell, and the ‘substance’ in the core.” Action at 3. In the event that the species elections provided above are deemed unsatisfactory in any way, the Applicants request that the next communication from the USPTO more clearly delineate the bounds of the species from among which the election is being requested in accord with the content identified in MPEP § 809.02(a).

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CONCLUSION

In view of the above elections, the Applicant submits that the present application in condition for substantive examination culminating in allowance. A notice to that effect is respectfully requested.

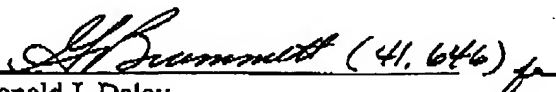
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-0750, including, in particular, extension of time fees.

Respectfully submitted,

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